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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/155,843	12/23/1998	SYLVESTRE JOBIC	A32002-PCTUS	9224

21003 7590 12/16/2003

BAKER & BOTTS  
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NEW YORK, NY 10112

EXAMINER
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WANG, SHENGJUN

ART UNIT	PAPER NUMBER
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1617

DATE MAILED: 12/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/155,843

Applicant(s)

JOBIC, SYLVESTRE

Examiner

Shengjun Wang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 and 17-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 17-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

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**DETAILED ACTION**

**DETAILED ACTION**

1. The request for a Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 09/155843 filed on June 30, 2003 is acceptable and a RCE has been established. An action on the RCE follows.

***Claim Rejections 35 U.S.C. – 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1 and 17-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over HIRAIWA DAIKU (JP52127936, of record and Derwent publication abstract No. 77-872784, IDS of Jan. 29, 1999, BD) in view of Yoshitomi Pharm. (Derwent publication abstract No. 81-06781D, IDS of Jan. 29, 1999, BE), Yamauchi (JP-0517732), Kodama et al. (WO 95/22902, IDS of Jan. 29, 1999, AB) and Metzner et al. (DE3536417).
3. HIRAIWA DAIKU teaches a wood adhesive composition consisting essentially of a suitable amount of insecticide and an adhesive. The preferred adhesives are thermosetting resins, e.g., phenol resin, and thermoplastic resins, e.g., polyvinyl acetate. The ratio of insecticides to the adhesive is about 1:10 to 1: 200. Agents known to be insecticidal may be used as the insecticide. See the abstract. The claims at page 297, and page 298 the right column.
4. HIRAIWA DAIKU does not teach expressly the employment of the specific insecticidal pyrazole compound, e.g., fipronil, and some of the specific adhesive resins, such as ethylene-

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vinyl-acetate copolymer, phenol-formaldehyde resin and resorcinol-formaldehyde resin, in the composition.

5. However, Kodama et al. teach that pyrazole compounds including fipronil are known to be useful as insecticides. See pages 2-3, particularly, page 2, lines 15-16. The compounds are particularly known to be useful against termites in various wood products such as plywood, particle board and furniture. See, particularly, page 6, lines 4-9. Yoshitomi Pharm teaches that phenol-formaldehyde resin and resorcinol-formaldehyde resin are known to be useful as wood adhesives. See the abstract. Yamauchi teaches that ethylene-vinyl acetate copolymer is known to be useful as a wood adhesive, wherein insecticide may be added. See, particularly, the abstract, and paragraph 27. Further, Metzner et al. teach that compositions consisting of adhesive and a biocide particularly against termites are known to be useful in wood products. See the abstract.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to modify the composition of HIRAIWA DAIKU by employing the specific compounds cited in the instant claims, e.g., fipronil as the insecticide and the specific resins cited in the instant claims as the adhesive resin.

A person of ordinary skill in the art would have been motivated to modify the composition of HIRAIWA DAIKU by employing the specific compounds cited in the instant claims, e.g., fipronil as the insecticide and the specific resins cited in the instant claims as the adhesive resin because pyrazole compounds including fipronil are known to be useful as insecticides against termites and compositions consisting of an adhesive and an insecticide particularly against termites are known to be useful in wood products. Further, all the resins employed in the instant claims are known to be useful as wood adhesives. The selection of a

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specific resin, e.g., ethylene-vinyl acetate copolymer, phenol-formaldehyde resin or resorcinol-formaldehyde resin is seen to be a selection from amongst equally suitable material and as such obvious, absent evidence to the contrary. Ex parte Winters 11 USPQ 2<sup>nd</sup> 1387 (at 1388).

Furthermore, wood based materials made with a composition suggested to be useful in wood based materials is considered within the skill of artisan.

***Response to the Arguments***

Applicants' remarks submitted June 30, 2003 have been fully considered, but are not persuasive for reasons discussed below.

6. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case, the primary references teaches wood adhesive composition comprising pesticidal agents, wherein the adhesive may be thermoset or thermoplastics, and the pesticidal agents may be any known pesticidal agents, secondary references teaches that the particular pesticidal agent is known specifically against termite, a wood pest. As stated above, considering the cited references as a whole, the claimed pesticidal adhesive composition is obvious.

7. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more,

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weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

8. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion, or motivation is found both in the references and the knowledge generally available to one of ordinary skill in the art. Particularly, because pyrazole compounds including fipronil are known to be useful as insecticides against termites and compositions consisting of an adhesive and an insecticide particularly against termites are known to be useful in wood products.

9. The examiner notes the legal standard for obvious is "reasonable expectation of success," not predictability. In view the fact that there is no particular limitation as to the pesticidal agents employed in the pesticidal wood adhesive composition (HIRAIWA DAIKU), and the fact that fipronil is particular useful against termite and useful in wood product, such as plywood. There is reasonable expectation that fipronil would be useful in a termiticidal wood adhesive composition.

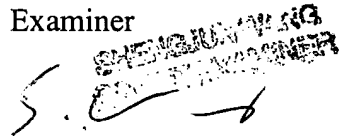
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (703) 308-4554. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Examiner



Shengjun Wang

December 4<sup>th</sup>, 2003